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**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

MIKE SARIEDDINE, an individual,)	CASE NO. 2:17-cv-2390-DSF-SK
)	
Plaintiff,)	SHENZHEN'S NOTICE OF
)	MOTION AND MOTION TO
vs.)	DISMISS SARIEDDINE'S
)	COUNTERCLAIMS AGAINST
D&A DISTRIBUTION, LLC (dba)	SHENZHEN
STRICTLY E-CIG), a Georgia limited)	
liability company et al.,)	DATE: April 23, 2018
)	TIME: 1:30 pm
Defendants.)	PLACE: Courtroom 7D
)	JUDGE: Hon. Dale S. Fischer

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE THAT on Monday, April 23, 2018 at 1:30 p.m., or as soon thereafter as this matter can be heard before the Honorable Dale S. Fischer of the United States District Court for the Central District of California, at First Street Courthouse, 350 West First Street, Courtroom 7D, Los Angeles, CA, 90012-4565, Defendant Shenzhen IVPS Technology Co, Ltd. (“Shenzhen”) will and hereby does move this Court to dismiss all counterclaims brought by Sarieddine against Shenzhen.

This Motion is based on this Notice, the accompanying Memorandum of Points and Authorities, the papers, records, and pleadings on file in this case, and on such oral argument as the Court allows.

This Motion is made following the conference of counsel pursuant to L.R. 7-3 which took place via teleconference on March 14, 2018 and at which the parties were unable to resolve their differences on this matter.

Dated: March 21, 2018

LOCKE LORD LLP

By: /s/ F. Phillip Hosp
F. Phillip Hosp

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TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. BACKGROUND	1
III. LEGAL STANDARD	2
IV. ARGUMENT.....	5
A. Sarieddine lacks standing to bring his asserted counterclaims.	5
B. Alternatively, even if Sarieddine possessed standing to pursue his counterclaims, the Court should exercise its discretion not to entertain Sarieddine’s counterclaims.	9
V. CONCLUSION	10

TABLE OF AUTHORITIES

Page(s)

Federal Cases

<i>Bassett v. ABM Parking Services, Inc.</i> , No. 16-35933, 2018 WL 987954 (9th Cir. Feb. 21, 2018).....	2
<i>Bobosky v. Adidas AG</i> , 843 F. Supp. 2d 1134 (D. Or. 2011).....	6
<i>California Ins. Guarantee Ass’n v. Price</i> , 252 F. Supp. 3d 948 (C.D. Cal. 2017).....	4, 10
<i>Coffman v. Breeze Corp.</i> , 323 U.S. 316 (1945).....	9
<i>E. Iowa Plastics, Inc. v. PI, Inc.</i> , 832 F.3d 899 (8th Cir. 2016)	4
<i>Famous Horse Inc. v. 5th Ave. Photo Inc.</i> , 624 F.3d 106 (2d Cir. 2010)	6
<i>Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A., Inc.</i> , 778 F.3d 1059 (9th Cir. 2015)	6
<i>Gov’t Employees Ins. Co. v. Dizol</i> , 133 F.3d 1220 (9th Cir. 1998)	4, 10
<i>Halicki Films, LLC v. Sanderson Sales & Mktg.</i> , 547 F.3d 1213 (9th Cir. 2008)	3
<i>Jackson v. Odenat</i> , 9 F. Supp. 3d 342 (S.D.N.Y. 2014)	6
<i>Ketab Corp. v. Limonadi</i> , No. 2-14-CV-07241, 2015 WL 5096417 (C.D. Cal. Aug. 28, 2015).....	3
<i>Ketab Corp. v. Mesriani & Associates</i> , No. 2-14-CV-07241, 2015 WL 8022874 (C.D. Cal. Dec. 4, 2015)	3
<i>Kythera Biopharmaceuticals, Inc. v. Lithera, Inc.</i> , 998 F. Supp. 2d 890 (C.D. Cal. 2014).....	1

1	<i>MedImmune, Inc. v. Genentech, Inc.</i> ,	
2	549 U.S. 118 (2007).....	3
3	<i>Sunrich Food Group, Inc. v. Pac. Foods of Oregon, Inc.</i> ,	
4	233 F. Supp. 2d 1273 (D. Or. 2002).....	3, 7
5	<i>Thoroughbred Legends, LLC v. The Walt Disney Co.</i> ,	
6	No. 1:07-CV-1275, 2008 WL 616253 (N.D. Ga. Feb. 12, 2008)	6
7	<i>Unique Sports Products, Inc. v. Wilson Sporting Goods Co.</i> ,	
8	512 F. Supp. 2d 1318 (N.D. Ga. 2007).....	6, 7
9	<i>Visioneer, Inc. v. KeyScan, Inc.</i> ,	
10	626 F. Supp. 2d 1018 (N.D. Cal. 2009).....	2
11	<i>Wells Fargo & Co. v. ABD Ins. & Fin. Services, Inc.</i> ,	
12	No. 12-3856, 2014 WL 4312021 (N.D. Cal. Aug. 28, 2014).....	6, 9
13	<i>Windsurfing Int’l Inc. v. AMF Inc.</i> ,	
14	828 F.2d 755 (Fed. Cir. 1987)	4
15	Federal Rules	
16	Federal Rule of Civil Procedure 12	1
17	Federal Statutes	
18	15 U.S.C. § 1125.....	6, 8
19	28 U.S.C. § 2201 (Declaratory Judgment Act).....	4
20	15 U.S.C. §§ 1051 et seq. (Lanham Act).....	1, 4, 5, 6, 7, 9
21	Other Authorities	
22	U.S. Constitution, Article III, section 2.....	2
23		
24		
25		
26		
27		
28		

I. INTRODUCTION

Throughout most of 2017, Sarieddine, a sole proprietor of e-juice, deceptively advertised that his products were sponsored by or affiliated with Shenzhen, an industry-leading manufacturer of vaporizers and vaporizer-related products. Shenzhen has asserted claims against Sarieddine for this false affiliation. Now, despite having no standing to do so, Sarieddine seeks to invalidate Shenzhen's unrelated trademarks.

False affiliation claims do not require proof of a valid trademark. Thus, Shenzhen's false affiliation claims against Sarieddine do not provide Sarieddine standing to challenge Shenzhen's marks. Accordingly, Shenzhen respectfully requests, pursuant to Fed. R. Civ. P. 12(b)(1), that the Court dismiss Sarieddine's asserted counterclaims against Shenzhen.

II. BACKGROUND

On March 28, 2017, Sarieddine brought this lawsuit against Shenzhen arising from Shenzhen's use of the word *alien*, and Sarieddine's purported rights in the marks ALIEN VAPE[®] and ALIEN VAPE. VAPE JUST GOT REAL![®]. (ECF No. 165.)

On February 12, 2018, Shenzhen filed its Second Amended Counterclaims, asserting four counterclaims against Sarieddine. (ECF No. 184.) Shenzhen's third counterclaim accuses Sarieddine of deception as to the sponsorship, affiliation, or endorsement of Sarieddine's goods by Shenzhen. (*Id.* at ¶¶ 84-87.) Shenzhen's fourth counterclaim accuses Sarieddine of unfair or fraudulent business acts or practices and of unfair, deceptive, untrue, and misleading advertising as a result of Sarieddine's deception.¹ (*Id.* at ¶¶ 88-92.) Shenzhen does not accuse, and has not accused, Sarieddine of trademark infringement.

On February 26, 2018, Sarieddine answered Shenzhen's counterclaims and asserted his own counterclaims against Shenzhen. (ECF No. 188.) On February 28,

¹ "[T]he Ninth Circuit 'has consistently held that state common law claims of unfair competition ... are 'substantially congruent' to claims under the Lanham Act.'" *Kythera Biopharmaceuticals, Inc. v. Lithera, Inc.*, 998 F. Supp. 2d 890, 897-98 (C.D. Cal. 2014).

2018, Saredidine amended his answer and counterclaims. (ECF No. 190.) Saredidine
 incorrectly asserts that Shenzhen “has accused Saredidine of . . . infringing its
 federally registered rights to the word SMOK” (*Id.* at 16.) He purports to deny
 his imagined “allegations of trademark infringement,” and concludes based on this
 alone that “there exists an actual case or controversy regarding whether Saredidine
 infringes SMOK’s numerous trademark rights to the term “SMOK” for e-cigarette
 products.” (*Id.*) On that mistaken basis, Saredidine’s counterclaims each challenge the
 validity of U.S. Trademark Registration Nos. 4545449 (SMOK), 4563001
 (SMOKTECH), 4676828 (SMOK TECHNOLOGY), 4676829 (SMOK MODS),
 4745398 (SMOK ECIG), 4805708 (SMOK), and 4764701 (SMOKTECH)
 (collectively, “Shenzhen’s Marks”) and seek invalidation of Shenzhen’s Marks and
 cancellation of the related registrations. (*Id.* at 31.)

III. LEGAL STANDARD

The Constitution limits the judicial power of federal courts to “to all Cases, in
 Law and Equity, arising under this Constitution, the Laws of the United States, and
 Treaties made, or which shall be made, under their Authority;” and “to Controversies
 between . . . a State, or the Citizens thereof, and foreign States, Citizens or Subjects.”
 U.S. Const. art. III, § 2, cl. 1. Implicit in this Constitutional limitation to such “cases”
 and “controversies” is the question of standing.

“Standing is a ‘threshold question in every federal case, determining the power
 of the court to entertain the suit.’” *Visioneer, Inc. v. KeyScan, Inc.*, 626 F. Supp. 2d
 1018, 1023 (N.D. Cal. 2009) (quoting *Warth v. Seldin*, 422 U.S. 490, 498 (1975)).
 Where a claimant lacks standing, the court must dismiss the claims. *Id.*

Generally, a claimant must allege 1) an injury in fact, 2) that is traceable to the
 challenged conduct of the other party, and 3) that is likely to be redressed by a
 favorable judicial decision. *Bassett v. ABM Parking Services, Inc.*, No. 16-35933,
 2018 WL 987954, at *2 (9th Cir. Feb. 21, 2018). In order to seek declaratory relief, a
 claimant must further demonstrate that a “substantial controversy” exists between

1 parties having “adverse legal interests,” as shown by “all the circumstances” of the
 2 case. *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007).

3 Further, in order to petition for cancellation of a trademark registration, a
 4 petitioner must have a “‘real interest’ in the proceeding.” *Halicki Films, LLC v.*
 5 *Sanderson Sales & Mktg.*, 547 F.3d 1213, 1228 (9th Cir. 2008). Such a petitioner
 6 “must show a real and rational basis for his belief that he would be damaged by the
 7 registration sought to be cancelled, stemming from an actual commercial or pecuniary
 8 interest in his own mark.” *Id.* at 1228-29 (quoting *Star-Kist Foods, Inc. v. P.J. Rhodes*
 9 *& Co.*, 735 F.2d 346, 349 (9th Cir. 1984)). The claimant “must show that he is ‘more
 10 than an intermeddler’ but rather has a personal interest, and that ‘there is a real
 11 controversy between the parties.’” *Ketab Corp. v. Limonadi*, No. 2-14-CV-07241,
 12 2015 WL 5096417, at *4 (C.D. Cal. Aug. 28, 2015) (quoting *Hokto Kinoko Co. v.*
 13 *Concord Farms, Inc.*, 810 F. Supp. 2d 1013, 1034 (C.D. Cal. 2011)). Courts have
 14 found standing for trademark cancellation based on “an assertion of a likelihood of
 15 confusion [between the petitioner’s mark and the registered mark at issue] which is
 16 not wholly without merit” and “a rejection of an application during prosecution.”
 17 *Halicki Films*, 547 F.3d at 1228.

18 Where a counterclaimant has not been sued for infringement, has no rights in a
 19 mark, and cannot credibly argue that they are or will be damaged by the continued use
 20 of the mark, the counterclaimant lacks standing to challenge the validity of the mark.
 21 *See, e.g., Ketab Corp. v. Mesriani & Associates*, No. 2-14-cv-07241, 2015 WL
 22 8022874, at *7 (C.D. Cal. Dec. 4, 2015) (dismissing a cancellation counterclaim for
 23 lack of standing because “Counterclaimants do not allege sufficient facts to show that
 24 they have standing to bring their cancellation claim”); *Sunrich Food Group, Inc. v.*
 25 *Pac. Foods of Oregon, Inc.*, 233 F. Supp. 2d 1273, 1276 (D. Or. 2002) (entering
 26 summary judgment for counterclaim defendant where counterclaimant lacked standing
 27 to petition for cancellation of the mark); *see also E. Iowa Plastics, Inc. v. PI, Inc.*, 832
 28 F.3d 899, 905 (8th Cir. 2016) (holding that a cancellation counterclaimant lacked

standing “because the Lanham Act protects both registered and unregistered trademarks,” and therefore the claimant would have faced the same potential liability if the trademark owner had never obtained a trademark registration by the alleged fraud); *Windsurfing Int’l Inc. v. AMF Inc.*, 828 F.2d 755, 758 (Fed. Cir. 1987) (claimant sought an impermissible advisory opinion and lacked standing where it had not been sued for infringement of the mark it sought to attack).

Even where a declaratory judgment claim passes constitutional and statutory muster, the exercise of declaratory judgment jurisdiction is discretionary. “[T]he district court must also be satisfied that entertaining the action is appropriate. This determination is discretionary, for the Declaratory Judgment Act is ‘deliberately cast in terms of permissive, rather than mandatory, authority.’” *Gov’t Employees Ins. Co. v. Dizol*, 133 F.3d 1220, 1223 (9th Cir. 1998) (quoting *Public Serv. Comm’n of Utah v. Wycoff Co.*, 344 U.S. 237, 250 (1952) (J. Reed, concurring)).

In the exercise of this discretion, the courts are “essentially balancing concerns of judicial administration, comity, and fairness to the litigants.” *California Ins. Guarantee Ass’n v. Price*, 252 F. Supp. 3d 948, 955 (C.D. Cal. 2017) (quoting *Principal Life Ins. Co. v. Robinson*, 394 F.3d 665, 672 (9th Cir. 2005)) (alterations in original omitted). Courts consider the following non-exhaustive factors: “whether the declaratory action will settle all aspects of the controversy,” “whether the declaratory action will serve a useful purpose in clarifying the legal relations at issue,” as well as “the convenience of the parties.” *Dizol*, 133 F.3d at 1225 (quoting *Am. States Ins. Co. v. Kearns*, 15 F.3d 142, 145 (9th Cir. 1994) (J. Garth, concurring)).

“[W]hen prudential considerations counsel against its use,” and a declaratory judgment “will neither serve a useful purpose in clarifying and settling the legal relations in issue nor terminate the proceedings and afford relief from the uncertainty and controversy faced by the parties,” declaratory relief should be denied. *California Ins. Guarantee*, 252 F. Supp. 3d at 955–56 (quoting *United States v. State of Wash.*, 759 F.2d 1353, 1357 (9th Cir. 1985)).

1 **IV. ARGUMENT**

2 **A. Sarieddine lacks standing to bring his asserted counterclaims.**

3 Sarieddine cannot allege any injury traceable to Shenzhen's Marks that would
 4 be redressed by the relief he seeks, and he cannot show a "real and rational basis for
 5 his belief that he would be damaged by the registration sought to be cancelled." Thus,
 6 there is no "actual controversy" with regard to Shenzhen's Marks. Accordingly, there
 7 is no subject-matter jurisdiction over Sarieddine's counterclaims, and they must be
 8 dismissed.

9 Sarieddine's assertion that Shenzhen "has accused Sarieddine of . . . infringing
 10 its federally registered rights to the word SMOK . . ." is either a fundamental
 11 misrepresentation or a basic misunderstanding of Shenzhen's counterclaims against
 12 Sarieddine. Shenzhen does not accuse and has not accused Sarieddine of trademark
 13 infringement. Rather, Shenzhen accuses Sarieddine of deception as to the sponsorship,
 14 affiliation, or endorsement of Sarieddine's goods by Shenzhen. Such *false affiliation*
 15 claims, also commonly referred to as *false endorsement* claims, are distinct from
 16 trademark infringement claims.

17 False affiliation claims under the Lanham Act do not require that the claimant
 18 possess a valid trademark. Rather, the Act states:

19 Any person who, on or in connection with any goods or services, or
 20 any container for goods, uses in commerce any word, term, name,
 21 symbol, or device, or any combination thereof . . . which—

22 (A) is likely to cause confusion, or to cause mistake, or to deceive as
 23 to the affiliation, connection, or association of such person with
 24 another person, or as to the origin, sponsorship, or approval of his or
 her goods, services, or commercial activities by another person, . . .

25 shall be liable in a civil action by any person who believes that he or
 26 she is or is likely to be damaged by such act.

27 15 U.S.C. § 1125(a)(1).
 28

Though “any word, term, name, symbol, or device, or any combination thereof” may include trademarks, the statute plainly does not require a valid trademark. “A false affiliation claim under section 43(a)(1)(A) of the Lanham Act . . . is similar to a trademark infringement claim, **but does not require proof of a valid trademark.**” *Wells Fargo & Co. v. ABD Ins. & Fin. Services, Inc.*, No. 12-3856 PJH, 2014 WL 4312021, at *7 (N.D. Cal. Aug. 28, 2014) (emphasis added); *Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059, 1068 (9th Cir. 2015) (permitting false endorsement claims based on the nonconsensual use of an party’s likeness); *Bobosky v. Adidas AG*, 843 F. Supp. 2d 1134, 1141 (D. Or. 2011) (“Possession of a federally registered trademark is not required to succeed in an action under § 43(a) of the Lanham Act”); *Famous Horse Inc. v. 5th Ave. Photo Inc.*, 624 F.3d 106, 110 (2d Cir. 2010) (“In contrast, § 43(a) goes beyond § 32 in making certain types of unfair competition federal statutory torts, whether or not they involve infringement of a registered trademark.”) (internal quotation omitted); *Jackson v. Odenat*, 9 F. Supp. 3d 342, 354 (S.D.N.Y. 2014) (“A trademark is not required for a successful section 43(a) claim”) (citing *Famous Horse Inc.*, 624 F.3d at 110); *Unique Sports Products, Inc. v. Wilson Sporting Goods Co.*, 512 F. Supp. 2d 1318, 1325 (N.D. Ga. 2007); *Thoroughbred Legends, LLC v. The Walt Disney Co.*, No. 1:07-CV-1275-BBM, 2008 WL 616253, at *12 (N.D. Ga. Feb. 12, 2008) (permitting a Lanham Act § 43(a) claim to survive despite dismissing trademark infringement claims “because Plaintiffs have not shown valid trademark rights”). Rather, the relevant question is whether consumers are likely to be confused as to whether the claimant endorsed the goods of the accused party.

In *Unique Sports*, the plaintiff accused defendants of false endorsement pursuant to section 43(a) of the Lanham Act based on allegations that the defendants had deceptively created a likelihood of consumer confusion regarding the affiliation, connection, or association with defendant’s product. 512 F. Supp. 2d at 1325. The defendant argued that the plaintiff’s claim was insufficient and subject to summary

1 judgment because the plaintiff could not prove that it had a valid trademark. *Id.* But
2 the court held that “[c]ontrary to defendant’s argument, plaintiff does not have to
3 prove that it has a valid trademark in Sampras’s image to prevail on its false
4 endorsement claim.” Rather, the plaintiff had a viable cause of action under
5 section 43(a) if consumers were likely to be deceived into falsely believing that
6 defendant’s product had been sponsored, endorsed, or approved. *Id.* On that basis, the
7 defendant’s motion for summary judgment was denied. *Id.*

8 In *Sunrich Food Group*, the plaintiff brought numerous claims against
9 defendants, some of which indirectly related to the plaintiff’s registered trademarks.
10 233 F. Supp. 2d at 1274. In response, the defendant asserted a counterclaim for
11 cancellation of plaintiff’s marks, on which the plaintiff sought summary judgment. *Id.*
12 at 1275. The defendant argued that it possessed standing based on the alleged failure
13 of plaintiff to police the use of its marks and based on alleged abandonment. *Id.* The
14 court found that the plaintiff’s complaint did not assert a claim for trademark
15 infringement and that the defendant had no other interest in the cancellation of the
16 marks. *Id.* at 1278. Therefore the defendant lacked standing to assert the counterclaim
17 for trademark cancellation. *Id.* at 1279.

18 Shenzhen’s Marks do not and have not harmed Saredidine in any way. Notably,
19 Saredidine does not allege that Shenzhen’s use of the marks challenged in his
20 counterclaims infringes on Saredidine’s own marks or that he has been prevented from
21 obtaining a mark of his own due to Shenzhen’s registrations. Saredidine does not
22 assert that he has been prevented from using any of Shenzhen’s Marks himself, or that
23 he seeks to do so in the future. That is, Saredidine has no real interest in the validity of
24 the marks, as he might if he sought to use the marks in commerce.

25 Indeed, Saredidine does not allege any injury stemming from Shenzhen’s Marks
26 or Shenzhen’s use of those marks except for his mischaracterization of Shenzhen’s
27 false affiliation claims as trademark infringement claims. Claiming that Shenzhen
28 “has accused Saredidine of . . . infringing its federally registered rights to the word

1 SMOK,” Sarieddine baldly alleges that “there exists an actual case or controversy
2 regarding whether Sarieddine infringes SMOK’s numerous trademark rights to the
3 term “SMOK” for e-cigarette products.” (ECF No. 190.) Shenzhen’s claims make no
4 such accusation.

5 While Shenzhen’s counterclaims against Sarieddine reference Sarieddine’s
6 usage of photographs containing Shenzhen’s mark SMOK without Shenzhen’s
7 consent, the counterclaims make that allegation as part of its claim that Sarieddine
8 sought to create the false impression through his social media advertisements that
9 Shenzhen IVPS Technology Co., Ltd. sponsored his goods even after he filed suit
10 against the company. His efforts to foster a connection to Shenzhen IVPS Technology
11 Co., Ltd. caused confusion and deception as to the affiliation, connection, or
12 association of Shenzhen to his goods, and the validity or invalidity of any mark is not
13 necessary for Shenzhen’s false affiliation claim. Shenzhen’s claims require only that
14 Sarieddine have used “any word, term, name, symbol, or device, or any combination
15 thereof . . . likely to cause confusion, or to cause mistake, or to deceive as to the
16 affiliation, connection, or association of such person with another person, or as to the
17 origin, sponsorship, or approval of his or her goods, services, or commercial activities
18 by [Shenzhen].” 15 U.S.C. § 1125(a)(1).

19 Further, Sarieddine’s sought-after relief would not provide him any redress. If,
20 for the sake of argument, Shenzhen’s Marks (such as SMOK ECIG) were invalidated,
21 it would not alter the fact that Sarieddine misused Shenzhen’s name, branding, and
22 symbols so as to deceive as to the sponsorship, affiliation, or endorsement of
23 Sarieddine’s goods by Shenzhen, and it would not lessen Sarieddine’s liability for
24 having done so. Simply put, even if each of Shenzhen’s Marks were deemed invalid
25 and each registration were cancelled, it would not resolve Shenzhen’s counterclaims
26 against Sarieddine, and it would not lessen Sarieddine’s liability for his false
27 affiliation, because Shenzhen’s false affiliation claims do not derive from and are not
28 dependent on its marks. Even without a single valid mark, Shenzhen could and would

1 still assert its false affiliation claim pursuant to section 43(a) of the Lanham Act. *See*
2 *Wells Fargo & Co. v. ABD Ins. & Fin. Services, Inc.*, C 12-3856 PJH, 2014 WL
3 4312021, at *7 (N.D. Cal. Aug. 28, 2014).

4 The primary controversy between Shenzhen and Sarieddine in this action is
5 whether Shenzhen has the right to use the word *alien* with regard to vaporizer
6 products. Sarieddine claims the right to prevent any other party from using the word in
7 the e-cigarette industry despite expressly and implicitly authorizing others including
8 Shenzhen to sell products named with that word. Sarieddine now seeks to inject the
9 validity of Shenzhen's unrelated marks into that dispute. But that does not create a
10 "substantial controversy" between parties having "adverse legal interests" in this case
11 with respect to Shenzhen's Marks. Because there is no substantial controversy
12 regarding Shenzhen's Marks, the relief Sarieddine seeks would amount to an
13 impermissible advisory opinion. *See Coffman v. Breeze Corp.*, 323 U.S. 316, 324
14 (1945) (noting that the declaratory judgment procedure "may not be made the medium
15 for securing an advisory opinion in a controversy which has not arisen").

16 Sarieddine does not and cannot allege any injury traceable to Shenzhen's Marks
17 that would be redressed by the relief he seeks. Sarieddine does not have a "real
18 interest" in the validity of Shenzhen's Marks. Rather, he is nothing more than an
19 intermeddler, who lacks any interest in the ongoing effect of the registrations he seeks
20 to cancel. For all of the foregoing reasons, Sarieddine lacks standing to pursue his
21 counterclaims against Shenzhen. Accordingly, there is no subject-matter jurisdiction
22 over Sarieddine's counterclaims against Shenzhen and they must be dismissed.

23 **B. Alternatively, even if Sarieddine possessed standing to pursue his**
24 **counterclaims, the Court should exercise its discretion not to**
25 **entertain Sarieddine's counterclaims.**

26 For all of the reasons discussed above, Sarieddine lacks standing to pursue his
27 declaratory judgment claims. But even if such standing existed, the relevant factors
28 weigh in favor of the Court declining to exercise its declaratory judgment jurisdiction

1 in this case. As has been discussed more thoroughly above, Sarieddine's
2 counterclaims are unrelated to the questions and claims at issue in this matter, and
3 their resolution in favor of either party would do nothing to settle the controversy or
4 govern Sarieddine's rights going forward. Sarieddine's declaratory judgment
5 counterclaims will not "serve a useful purpose in clarifying the legal relations at
6 issue," and would not serve "the convenience of the parties." *Dizol*, 133 F.3d at 1225
7 (quoting *Am. States Ins. Co. v. Kearns*, 15 F.3d 142, 145 (9th Cir. 1994) (J. Garth,
8 concurring)). On the contrary, a declaratory judgment on Sarieddine's counterclaims,
9 in favor of either party, would "neither serve a useful purpose in clarifying and
10 settling the legal relations in issue nor terminate the proceedings and afford relief from
11 the uncertainty and controversy faced by the parties." *California Ins. Guarantee*, 252
12 F. Supp. 3d at 955–56 (quoting *United States v. State of Wash.*, 759 F.2d 1353, 1357
13 (9th Cir. 1985)). Accordingly, because prudential considerations counsel against its
14 use, declaratory relief should be denied.

15 **V. CONCLUSION**

16 As a sole proprietor of e-juice, Sarieddine sought to increase his sales by
17 attaching himself to an industry leader and by deceptively advertising that his products
18 were sponsored by or affiliated with that leader. Now, in a misguided attempt to
19 escape liability for his actions, Sarieddine seeks to invalidate Shenzhen's trademarks.

20 Because Sarieddine lacks standing to challenge the validity of Shenzhen's
21 Marks and seek cancellation, his counterclaims are improper and without subject-
22 matter jurisdiction. Alternatively, even if Sarieddine possessed the necessary standing,
23 the Court should exercise its discretion not to entertain Sarieddine's counterclaims.

24 Accordingly, Shenzhen respectfully requests that the Court dismiss Sarieddine's
25 asserted counterclaims against Shenzhen.
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1 Dated: March 21, 2018

Respectfully submitted,

2 LOCKE LORD LLP

3
4 By: /s/ F. Phillip Hosp
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